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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,398	04/03/2001	Terence David Sanger	17420-013	2948

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EXAMINER

YANG, RYAN R

ART UNIT	PAPER NUMBER
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2672

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,398

Applicant(s)

SANGER, TERENCE DAVID

Examiner

Ryan R Yang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 4,5,7,9-13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-18 are pending in this application. Claims 1, 14, 17 and 18 are independent claims. This Action is non-final.
2. This application claims benefit of 60/194,347 dated 04/03/2000.
3. The present title of the invention is "Method and apparatus for sending electronic mail using human handwriting".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

- The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
5. Claims 1-3, 6, 8 and 14-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Powers (6,446,115).

As per claim 1, Powers discloses a method for generating an electronic mail message containing simulated handwriting, comprising the steps of:

accessing a website having a user interface (Figure 1 10 WWW Server);
entering a text message through the user interface (Figure 1 17 Composition Server);

creating a graphic image of simulated handwriting that corresponds to the text message ("Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a graphical representation of the correspondence is sent to the sender for review", column 18, line 13-16).

6. As per claim 2, Powers demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses a step of specifying one or more formatting parameters (Figure 3B 41 Determine size, type, format ...).

7. As per claim 3, Powers demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the specifying step includes choosing a pen type (Figure 3B 41 Determine size, type ...).

8. As per claim 6, Powers demonstrated all the elements as applied to the rejection of claim 2, supra, and further discloses the specifying step includes choosing size of lettering (Figure 3B 41 Determine size ...).

9. As per claim 8, Powers demonstrated all the elements as applied to the rejection of claim 2, supra, and further discloses the specifying step includes choosing a handwriting script (Figure 3B 41 Determine ... signature for letter from data).

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10. As per claim 14, Powers discloses a system for sending and receiving an electronic mail (email) message, wherein a portion of the email message has a handwritten appearance, comprising:

- a network (Figure 1 16);

- a first access device associated with an email sender and connected to the network, wherein the first access device further comprises means for entering a text message and formatting parameters (Figure 1 17 Composition Server);

- a second access device associated with an email recipient and connected to the network (Figure 1 16 Internet, indicating one or more computers are connected through the network); and

- a server connected to both the first access device via the network and the second access device via the network, for receiving the text message from the first access device, for converting the text message into a graphic image containing simulated handwriting and for forwarding the graphic image to the second access device (Figure 1 10 WWW Server).

11. As per claim 15, Powers demonstrated all the elements as applied to the rejection of independent claim 14, supra, and further discloses the text message is converted into a graphic image using a software program on the server (Figure 1 10 WWW server and "Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a graphical representation of the correspondence is sent to the sender for review", column 18, line 13-16).

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12. As per claim 16, Powers demonstrated all the elements as applied to the rejection of claim 15, supra, and further discloses the software program uses the text message and formatting parameters to generate a high-resolution graphic image ("the following steps describe a preferred embodiment for automatic activities performed for the sender ... 4) The appropriate high-resolution graphics for the stationary, card or letterhead are retrieved from the database", column 9, line 53 – column 10, line 3).

13. As per claim 17, Powers discloses a method for converting a text message into a communication message containing a graphic image of simulated handwriting, comprising the steps of:

receiving a text message from a first site on a communications network (Figure 1 17 Composition Server where the text message is created, column 18, line 13);

converting the text message into the end user communication message containing a graphic image of simulated handwriting, wherein the format of the communication message is capable of being recognized by a user ("Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a graphical representation of the correspondence is sent to the sender for review", column 18, line 13-16); and

transmitting the converted communication message to the user at a second site (Figure 1 16 Internet, indicating one or more computers are connected through it).

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14. As per claim 18, Powers discloses a computer program embodied on a computer readable medium for converting a text message into an email message (Figure 1 17 Composition Server), said computer program accomplishing the steps of:

receiving a text message and a set of formatting parameters from an end user from a first site (Figure 1 17 Composition Server where the text message is created, column 18, line 13);

converting the text message into a graphic image containing simulated handwriting ("Once the correspondence has been created with the text of the email message along with template information from the database (such as a letterhead), a graphical representation of the correspondence is sent to the sender for review", column 18, line 13-16); and

transmitting the graphic image to at least one end user at a second site (Figure 1 16 Internet, indicating one or more computers are connected through it).

Allowable Subject Matter

15. Claims 4-5, 7 and 9-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter:

As per claim 4, the closest prior art by Powers (6,446,115) discloses a method of generating and emailing handwritten message, however, he does not disclose specifying step includes ballpoint, felt-tip and calligraphic.

As per claim 5, the closest prior art by Powers discloses a method of generating and emailing handwritten message, however, he does not disclose the specifying step includes choosing a degree of messiness.

As per claim 7, the closest prior art by Powers does not disclose the specifying step includes choosing between a wandering text baseline and a straight text baseline.

As per claim 9, the closest prior art by Powers does not explicitly disclose the handwriting creating step includes accessing and selecting letter shapes from the handwriting script database that correspond to the text message; joining the letter shapes; and drawing the strokes to create the graphic image.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inquiries

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Ryan Yang** whose telephone number is **(703) 308-6133**.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Razavi**, can be reached at **(703) 305-4713**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

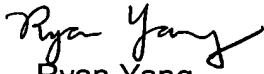
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


Ryan Yang
April 7, 2003